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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,520	08/17/2001	Timothy T. Wenzel	1999U021D1.US	5087

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UNIVATION TECHNOLOGIES LLC
5555 SAN FELIPE, SUITE 1950
HOUSTON, TX 77056

EXAMINER

PASTERCZYK, JAMES W

ART UNIT PAPER NUMBER

1755

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,520

Applicant(s)

WENZEL ET AL.

Examiner

J. Pasterczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-14,35-37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-14,35-37 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/24/03
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. This Office action is in response to the amendment filed 12/11/03 and IDS filed 10/21/03 and refers to the rejection mailed 8/14/03.

2. The prior art rejection is withdrawn due to amendment. However, note the maintained rejections below.

3. Claims 1, 4-14, 35-37 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, l. 2, insert --with each other-- after "react" to make it clear what reacts with what in the composition.

Claims 11, 12 and 39 are missing periods at the ends of each claim.

In claim 12 place a space after "claim 11".

In claim 35, l. 3, it is not clear toward what the base and acid compounds are unreactive at the polymerization operation temperature.

4. Claims 1, 4-14, 35-37 and 39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the acid being L-malic acid, the base being an alkali or alkaline earth carbonate, and the catalyst being an early transition metal metallocene, does not reasonably provide enablement for the acids or bases being anything else and the catalyst being anything else. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

The claims as written are extremely broad. As a result, one of ordinary skill in the art would have to engage in much experimentation to discover the proper combination of acid, base

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and catalyst to arrive at a workable catalyst that above some temperature would be deactivated by the reaction product of the acid and base acting upon the catalyst itself. Not only would one of ordinary skill in the art have to experiment with these three variables, he would also have to experiment with the variables of time of reaction, temperature, pressure, solvents, and likely others, not only in the preparation of the catalyst, but its use, to arrive at a working catalyst. The proper combination of acid and base would have to be coupled with the proper catalyst, taking into account what compounds deactivate the catalyst since not all compounds resulting from the reaction of a given acid and base necessarily deactivate all catalysts. In addition, the catalyst arts are notoriously unpredictable, and catalyst deactivation, while possibly being well-understood on a catalyst-by-catalyst basis, is not necessarily the same across the full breadth of catalysts presently claimed, hence applicants' appeal to other art in the literature is not necessarily availing. In particular, invocation of USP 6,346,584 is not necessarily probative; in that reference (the ancestor of the present application), the bulk of the examples given in the Background section appear to deal more with issues of mechanical heat transfer, static electric build-up, and other merely mechanical methods and the fouling resulting therefrom rather than actual chemical inhibition of the catalyst's activity. Furthermore, as applicants are aware, each application is examined on its own merits; the patenting of one application does not necessarily indicate another application related to the first will be allowed. Finally, contrary to applicants' assertion in their argument, based on the examiner's own laboratory experience not all combinations of one solid with another necessarily results in a liquid, even above room temperature, and the claims do not require that the reaction product of the two solids be a liquid, also contrary to applicants' argument.

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Further regarding applicants' own disclosure, the examiner notes that at p. 20, l. 10, a number of other combinations of acids and bases are "contemplated". Use of this word suggests that these are merely prophetic examples, not actual known, working examples. The only actual working examples disclosed use one single metallocene compound, one single acid, and two bases. Such narrow experimentation is not indicative of enablement for such broadly worded claims.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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JP

1/23/04



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700